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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/656,506 | 09/04/2003 | Paul Anthony Halstead | 33528/RFT/VEJ | 8021 |

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EXAMINER

BRITTAIN, JAMES R

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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3677

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|--|--|
| Office Action Summary | Application No. 10/656,506 | Applicant(s) HALSTEAD, PAUL ANTHONY | |
| | Examiner James R. Brittain | Art Unit 3677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>12152003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawing Objections

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the flexible hinge (claim 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no indication how the flexible hinge is devised so as to permit one having ordinary skill in the art to make and use the device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

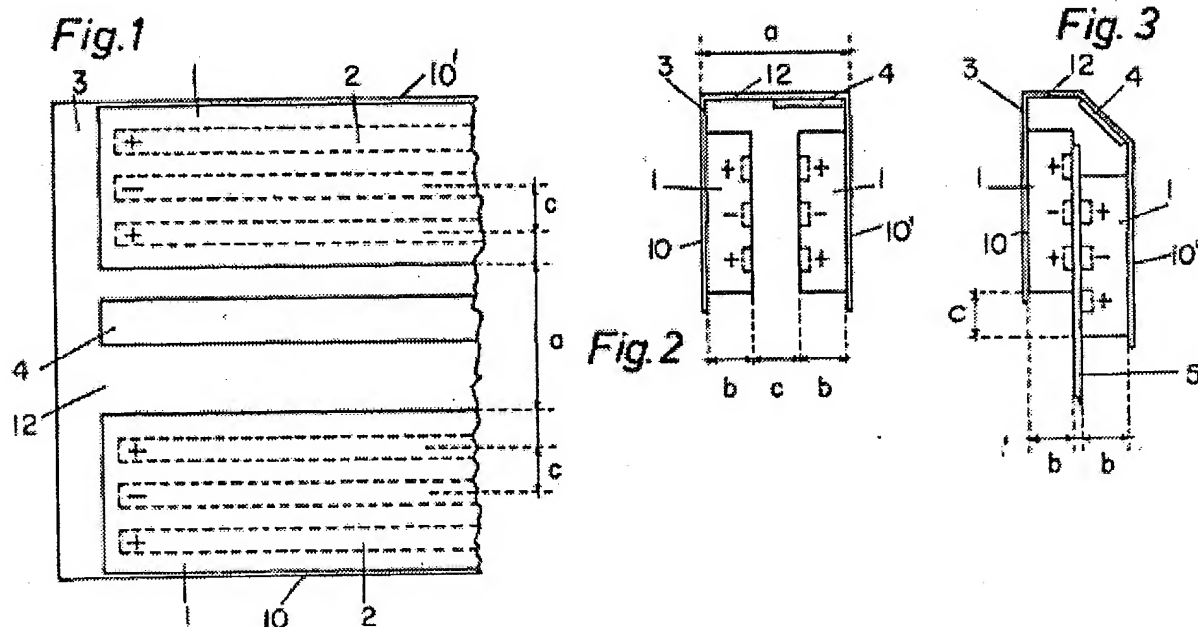
Claims 4-6, 10-14 and 18 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Hutter (US 4222489).

Hutter (figures 1-3) teaches a clip for holding paper and therefore inherently capable of holding banknotes having a first clasp portion 10' and a second clasp portion 10 for holding banknotes therebetween, the first clasp portion having a first magnetic portion 1 including magnetic material and the second clasp portion having a second magnetic portion 1 including magnetic material, wherein the first magnetic portion is moveable relative to the second magnetic portion between: a closed position whereby the interaction of the magnetic material of the first and second magnetic portions is such that there is a net force of attraction to hold the first and second clasp portions together; and an open position whereby the first and second clasp portions are released apart. Figure 1 shows that there are spaced bands 2 of alternating polarity sequentially arranged across the width of the clamp and generate an open configuration when the facing polarities are alike (figure 2) and a closed configuration when the facing polarities are opposite (figure 3). The polarity of each band 2 inherently reverses through the thickness of the band. A flexible hinge connects the two clasp portions together and permits the requisite movement for the operation of the clasp (col. 4, lines 57 - col. 6, line 3 and col. 6, lines 10-15).

Magnets 2 may also be viewed as forming different polarized boundary regions 2 arranged adjacent to each other on common support 3 and at the edge distance a, which corresponds approximately to double the thickness b of strip 1 plus the center distance c between the differential polarized regions 2. Accordingly, strips 1 which face each other can be moved by their lengthwise folding either into a clamping position according to FIG. 3 and/or 4, where they adhesively face each other as a result of their mutual shift by center distance c. Or, according to FIG. 2 they can be obliquely shifted or moved into an open release-and/or pickup position

where they congruently face each other so as to repel each other as a result of the equally polarized regions 2 at the approximate distance c.

The mutual repulsing as shown by the arrows in FIG. 10 of strips 1 congruently facing each other is converted to a force close-clamping the inserted blade shaped material 5, as shown in FIG. 3, as soon as both strips are mutually vertically and obliquely shifted by wall 12 through the center distance c of polarized regions 2. 15



Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 7-9 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Hutter (US 4222489) in view of Beyer et al. (US 3468576).

Hutter (figures 1-3) teaches a clip for holding paper and therefore inherently capable of holding banknotes having: two clasp portions 10, 10' moveable relative to one another for holding the paper therebetween; and magnetic material 1 operably associated with the clasp portions, the magnetic material being moveable between a first closed position whereby the

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operation of the magnetic material is such as to hold the first and second clasp portions together and an open position whereby the first and second clasp portions are released apart. A flexible hinge connects the two clasp portions together and permits the requisite movement for the operation of the clasp (col. 4, lines 57 - col. 6, line 3 and col. 6, lines 10-15). The difference is that the magnetic material is fixed to the clasp portions and depends upon the flexible hinge to permit the relative movement of the magnetic material rather than having a movable portion carrying the magnetic material upon one of the clasp portions. However, Beyer et al. (figures 1-5) teaches latch structure for a fixedly hinged door wherein the magnetic latch is such that it can be slid by an operator extending through the door from a closed position wherein the opposite polarities are facing to an open position wherein the like polarities are facing so as to repel the door open. As it would be advantageous to utilize a stronger pintle secured hinge for the clasp of Hutter, it would have been obvious to modify the clasp of Hutter so that the magnetic material is carried in a movable portion relative to a clasp portion so as to benefit from the use of facing opposite polarities which create open and closed latching configurations while permitting the use of a stronger pintle hinge as taught by Beyer et al. to be desirable.

Claim 16 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hutter (US 4222489) in view of Mars (US 6282760).

Hutter (figures 1-3) teaches a clip for holding paper and therefore inherently capable of holding banknotes having: two clasp portions 10, 10' moveable relative to one another for holding the paper therebetween; and magnetic material 1 operably associated with the clasp portions, the magnetic material being moveable between a first closed position whereby the operation of the magnetic material is such as to hold the first and second clasp portions together

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and an open position whereby the first and second clasp portions are released apart. A flexible hinge connects the two clasp portions together and permits the requisite movement for the operation of the clasp (col. 4, lines 57 - col. 6, line 3 and col. 6, lines 10-15). The difference is that the magnetic material is not stated as being rare earth magnets. However, such magnets are common and well known for their good qualities as taught by Mars (figure 8; col. 4, lines 9-19) which suggests Neodymium-Iron-Boron magnets as having strong magnetic properties so as to clamp material between two such magnets. As it would be beneficial for the clasp of Hutter to possess good clamping characteristics it would have been obvious to utilize rare earth magnets as suggested by Mars because of Mars recognizing their strong magnetic properties that would be useful in the clamping arts.

Claim 15 is rejected under 35 U.S.C. §103(a) as being unpatentable over Hutter (US 4222489) in view of Beyer et al. (US 3468576) as applied to claim 1 above, and further in view of Mars (US 6282760).

Further modification of the clasp of Hutter such that rare earth magnets are utilized would have been obvious in view of Mars (figure 8; col. 4, lines 9-19) teaching the use of Neodymium-Iron-Boron magnets as having strong magnetic properties so as to clamp material between two such magnets

Conclusion

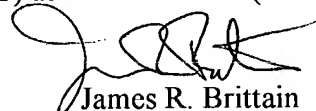
The patent of Schirmuly (EP 29500, figure 2) teaches pertinent magnetic clasp structure with a floating hinge.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James R. Brittain whose telephone number is 703-308-2222. The examiner can normally be reached on M, W & F 5:30-1:30, T 5:30-2:00 & TH 5:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James R. Brittain
Primary Examiner
Art Unit 3677

JRB